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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,932	04/19/2004	Craig Neil DeVarney		1618

7590 12/03/2004  
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EXAMINER

LEGESSE, NINI F

ART UNIT PAPER NUMBER

3711

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/826,932

Applicant(s)

DEVARNEY, CRAIG NEIL

Examiner

Nini F. Legesse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-5** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The expression "a device included with a golf club that plays a sound file, comprising the steps of" in line 1 of claim 1 is unclear. It is not clear if Applicant is intending to claim a device or a method of using a device. However, **for purpose of examining the claims, it is assumed that Applicant is claiming a device and the claims are examined accordingly.**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1 and 5** are rejected under 35 U.S.C. 102(e) as being anticipated by Keheley (US Patent No. 5,868,633).

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**With regards to claim 1**, Keheley teaches the use of sound files that are digitally stored (6) in a golf club (see Fig. 2). Please note that since the claim is assumed to be a product claim, the expressions in lines 2-3 of claim 1 are not considered.

**With regards to claim 5**, wherein the origin of sound is at the head of the golf shaft, distal to the grip end (6 and 7).

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-3** are rejected under 35 U.S.C. 102(e) as being anticipated by Barton (US Patent No. 6,746,247).

**With regards to claim 1**, Barton teaches the use of sound files that are digitally stored (in column 3 lines 4-5 he discloses a compact disc as a storage medium) for athletic movement including the game of golf (see column 5, lines 40-65). Please note that since the claim is assumed to be a product claim, the expressions in lines 2-3 of claim 1 are not considered.

**With regards to claim 2**, the sound file comprises of an arrangement of musical notes in expressive succession representing the rhythm and timing of an athletic activity (see column 5 line 5+ and see Figs. 1-4).

**With regards to claim 3**, the sound produced is audibly continuous, without pause for the entirety of the sound file (see columns 5 and 6).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 4** is rejected under 35 U.S.C. 103(a) as being unpatentable over Barton.

Barton discloses the invention as recited above, but he fails to explicitly state wherein the recorded sound file includes the sound of the striking of a golf ball with a golf club. However in column 5 lines 54-58 he states that a musical note on a beat within the beat pattern that corresponds to an impact event within the athletic activity could be provided and he gave the impact of a ball to a baseball as an example. It is noted that he has indicated that his invention could be used with golf in his column 5 of the reference. Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a sound of the striking of a golf ball with a golf club when the device is to be used for golf so that it could serve as an instructional tool for a golfer teaching him/her rhythm, timing and tempo.

**Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over Barton in view of Keheley.

Barton fails to locate the origin of sound at the head of a golf club. On the other hand Keheley discloses a golf club wherein the origin of sound is at the head of a golf club (see the location of sound chip 6 and speaker 7 in Fig. 2). Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a golf club that incorporate the teaching of Barton and saving the composed song for a golf swing on a sound chip as taught by Keheley's device in order to provide an integrated device that is both sound generating and practicing element that is capable of teaching rhythm, timing, and tempo to a golfer.

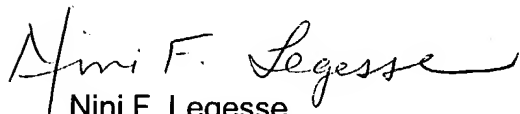
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nini F. Legesse whose telephone number is (571) 272-4412. The examiner can normally be reached on 9:30 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on (571) 272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Nini F. Legesse  
11/19/04